

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

ORACLE AMERICA, INC.,
Plaintiff,

No. C 10-03561 WHA

v.

**ORDER REGARDING PATENT
MARKING DISPUTE**

GOOGLE INC.,
Defendant.

In the order denying Google's motion for partial summary judgment on its patent marking defense, the Court expressed concern that disputes over which Oracle or Sun products practiced the asserted claims, and therefore required marking, would devolve into an "infringement" type analysis at trial. In order to streamline the issue for trial, the parties were required to devise a fully agreeable procedure to identify and stipulate to the Oracle or Sun products that practiced the asserted claims. The parties filed a joint, stipulated procedure (Dkt. No. 661).

Now, it is manifestly clear that Google failed to comply with its own stipulated procedure. Pursuant to the first step in the joint procedure, Oracle submitted a list of Oracle and Sun products that practiced each of the asserted patents, the supporting source-code citations for each product, and summary of testimony it intended to elicit at trial in support of these identifications. Pursuant to the next step in the joint procedure, Google was required, by January 20, to:

respond to Oracle and identify any other Oracle products that Google contends practiced any of the 26 asserted claims during the alleged damages period and identify any products in Oracle's identification that Google contends do not practice the identified claims. Google's response will specify which Oracle products it contends do (or do not) practice the asserted claims, and why.

1 Google failed to do so. Instead, Google merely objected to Oracle's testimonial evidence and
2 complained that it did not have time to analyze the source-code citations provided. Google did
3 not independently analyze and address each product identified by Oracle. Nor did Google
4 identify any other products that practiced the asserted claims.

5 Google is hereby ordered to stand and deliver on its end of the bargain. For each product
6 identified by Oracle, Google shall independently analyze whether that product practiced the
7 asserted claims. Google cannot merely object to Oracle's evidence. Note well that Google is the
8 one who raised the patent marking defense and presumably has its own evidence to show which
9 Sun or Oracle products fell within the asserted claims. Google has no need to see more evidence
10 to lay out its hand on this score. Google must unequivocally state whether each product practiced
11 or did not practice the asserted claims. For each contention, Google must provide an explanation
12 based on its own analysis of the product. Google must faithfully comply or withdraw its patent
13 marking defense. If Google fails to do so by **NOON ON FEBRUARY 14**, then the Court will
14 entertain a motion to eliminate the patent marking defense.

15 With respect to Google's suggestion that Oracle has not previously produced the code and
16 other evidence, Oracle replies that is wholly untrue and that all such evidence has previously been
17 produced in discovery (Dkt. No. 706 at 6–21). This question would only affect the products and
18 methods asserted *by Oracle* as falling within the claims and would *not* affect the products and
19 methods asserted *by Google* as falling within the claims. As to the latter, Google should already
20 have the evidence to back up its own contentions. As to the former, if it is really true that Oracle
21 has neglected to produce the evidence cited by Oracle in its step one submission, then Google
22 may in its February 14 submission, specify the missing evidence with particularity. Oracle shall
23 then have until **NOON ON FEBRUARY 17** to admit or deny the assertion of non-production, stating
24 with particularity, if Oracle contends it was produced earlier, when, how, and to whom, the
25 evidence was produced, taking care to admit any part of the allegedly-missing evidence was not
26 produced. This issue, even if it is a genuine one, cannot justify the wholesale refusal to respond
27 at all as required by the stipulation.
28

1 Until Google faithfully complies with its own stipulated procedure, Oracle will not be held
2 to its step one admissions, *that is*, Google may not simply assert that Oracle has admitted a failure
3 to mark and therefore there is no need for Google to admit or deny in order to defend on grounds
4 of failure to mark. First, such a tactic would violate the stipulation. Second, such a tactic would
5 be gamesmanship to “have it both ways” so as to have the benefit of the procedure without having
6 to admit items that may hurt Google on other issues, such as the question of an injunction should
7 Google lose at trial.

8 As required by their own stipulation, the parties shall have a meet-and-confer regarding
9 their disclosures (this time with an acceptable disclosure from Google) with the aim of preparing
10 a stipulation of which products practice the asserted claims. By **NOON ON FEBRUARY 21**, the
11 parties shall jointly submit to the Court their stipulations, a statement on the evidentiary effect of
12 their stipulations at trial, and a list of those products for which there is a genuine dispute between
13 the parties, along with brief explanations of the basis for each party’s contention for each product.

14
15 **IT IS SO ORDERED.**

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17 Dated: January 31, 2012.



WILLIAM ALSUP
UNITED STATES DISTRICT JUDGE